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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/997,390      | 11/30/2001  | Stephen D. Pacetti   | 50623.00 62         | 5559             |

7590 10/08/2004

Squire, Sanders & Dempsey L.L.P.  
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San Francisco, CA 94111

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| EXAMINER |
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HO, UYEN T

|          |              |
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| ART UNIT | PAPER NUMBER |
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3731

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,390

Applicant(s)

PACETTI, STEPHEN D.

Examiner

(Jackie) Tan-Uyen T. Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 9-19, 23-28 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 20-22, 29-31, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, Species I (Claims 1-8, 20-22, 29-31, 33 and 34) in the reply filed on 7/23/04 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 20, 21, 22, 29, 30, 31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg et al. (5,464,650) in view of De Scheerder et al. (6,572,651). Berg et al. disclose all the limitation of the claims except for the presence of a step of modifying the ratio of the first ingredient with respect to the second ingredient in the coating formulation as the coating formulation is being applied to the stent. De Scheerder et al. disclose a stent comprising two coating ingredients. De Scheerder et al. teach that modifying the ratio of the first ingredient with respect to the second ingredient in the coating formulation as the coating formulation is being applied to the stent to form a transition layer for improving the adhesion between ingredient layers (col. 2, line 47-66). It also known in the art to form transition layer or graded layer between coating layers in order to provide a better adhesion between coating layers. Therefore, it would have been obvious to one having ordinary skill in the art at the time

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the invention was made to employ a transition layer into Berg et al.'s stent in order to provide a better adhesion between coating layers of the stent. Doing so would meet all the limitation of the claims.


4. Claims 1-8, 20, 21, 22, 29, 30, 31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuch (5,624,411) in view of De Scheerder et al. (6,572,651). Tuch et al. disclose all the limitation of the claims except for a presence of a step of modifying the ratio of the first ingredient with respect to the second ingredient in the coating formulation as the coating formulation is being applied to the stent. De Scheerder et al. disclose a stent comprising two coating ingredients. De Scheerder et al. teach that modifying the ratio of the first ingredient with respect to the second ingredient in the coating formulation as the coating formulation is being applied to the stent to form a transition layer for improving the adhesion between ingredient layers (col. 2, line 47-66). It also known in the art to form transition layer or graded layer between coating layers in order to provide a better adhesion between coating layers. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a transition layer into Tuch's stent in order to provide a better adhesion between coating layers of the stent. Doing so would meet all the limitation of the claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN or NGUYEN can be reached on 703-308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho  
Patent Examiner  
Art Unit 3731

October 6, 2004